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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/062,113 04/17/98 GOTO

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021323 HM22/0806
TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

EXAMINER

ROMEO, D	ART UNIT	PAPER NUMBER
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1647
DATE MAILED:

08/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/062,113

Applicant(s)

Goto et al.

Examiner

David Romeo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 May 2001
 - 2a) This action is FINAL. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 32-34 and 41-46 is/are pending in the application.
 - 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) 32, 34, 41, 43, 44, and 46 is/are allowed.
 - 6) Claim(s) 33, 42, and 45 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

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DETAILED ACTION

1. The request filed on 05/24/2001 (Paper No. 18) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09062113 is acceptable and a CPA has been established. An action on the CPA follows.

2. The amendment filed 05/24/2001 (Paper No. 19) has been entered. Claims 32-34, 41-46 are pending and being examined. Any objection and/or rejection of record that is not maintained and/or repeated in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The abstract of the disclosure is objected to because it is not a single paragraph. A substitute abstract on a separate sheet is required. See MPEP § 608.01(b). It is acknowledged that Applicants will correct the abstract in a substitute specification.

4. A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because the interlineations or cancellations made in the specification could lead to confusion and mistake during the issue and printing processes. Accordingly, the specification is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q). It is

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acknowledged that Applicants will provide a substitute specification upon the identification of allowable subject matter.

5. The application is not fully in compliance the sequence rules, 37 C.F.R. § 1.821-1.825.

Correction is required. It is acknowledged that Applicants will bring the application into 5 compliance in a substitute specification.

6. Claims 33, 42, 45 are rejected under 35 U.S.C. § 112, second paragraph, over the recitation of "an isolated protein encoded by a polynucleotide comprising the nucleotide sequence" because a nucleotide sequence has six reading frames, three forward and three reverse, and encodes at least six different proteins. It is unclear which protein is intended. Applicants 10 argue that the amendments should overcome the rejection. Applicants' arguments have been fully considered but they are not persuasive. In view of the use of the indefinite article, the broadest reasonable interpretation of the claim is that it is directed to an isolated protein corresponding to any contiguous subset of the codons within the polynucleotide. It is unclear which protein is intended. The metes and bounds of the claim(s) are not clearly set forth.

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New formal matters, objections, and/or rejections:

7. The nucleotide and/or amino acid sequence database records cited in the information disclosure statement filed 05/24/2001 have been considered to the extent possible. However, a residue by residue comparison has not been done.

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Claim Rejections - 35 USC § 112

8. Claims 33, 42, 45 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a protein comprising the amino acid sequence of SEQ ID NO: 62, 65, or 66, does not reasonably provide enablement for a protein encoded by a polynucleotide comprising the nucleotide sequence of SEQ ID NO: 83, 86, or 87. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Claims 33, 42, 45 specify "an isolated protein encoded by" the polynucleotide of SEQ ID NO: 83, 86, or 87. In view of the use of the indefinite article, the broadest reasonable interpretation of the claim is that it is directed to an isolated protein corresponding to any contiguous subset of the codons within the polynucleotide. The claims accordingly read on proteins having no function identified in the specification. They additionally read on proteins encoded by alternate reading frames within the polynucleotide. Such proteins would be entirely unrelated in structure to the OCIF amino acid sequences described. Absent either a useful functional property or any structural (and

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hence functional) relationship to the exemplified protein corresponding to the full scope of the subject matter claimed, the artisan cannot use all of the claimed materials for any purpose described in the disclosure absent undue experimentation.

Conclusion

- 5 9. Claims 32, 34, 41, 43, 44, 46 are allowable.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M.

10 IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

OFFICIAL PAPERS FILED BY FAX SHOULD BE DIRECTED TO (703) 308-4242.

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

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David Romeo
DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

AUGUST 3, 2001